

**REMARKS**

Claims 1-3, 5-7, 11-16, 18-21, 23-27, 29-32 and 35-43 are pending.

**I. Claim Rejections - § 112**

Claims 12 and 15-20 are rejected under 35 U.S.C. § 112, second paragraph. Applicants amend claim 12 to remove any ambiguities.

**II. Claim Rejections – Prior Art**

Claims 1-3, 5-7, 11-16, 18-21, 23-27, 29-32 and 35-43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Imanishi (2004/0116578) in view of Oishi (6,676,920).

Claims 1, 11-14, 21, 23, 24, 27 and 32 are in independent form; therefore, the following discussion is initially directed to these independent claims.

As noted by the Examiner, Imanishi does not disclose that the magnesium hydroxide is formed from a reaction of a magnesium salt and a metal hydroxide. Imanishi is directed to a process of making granular inorganic filler to be used in resin compositions.

Oishi discloses a method of making magnesium hydroxide as filler for flame retardant compositions. In particular, this reference is directed to forming magnesium hydroxide into particles having a hexagonal crystal form (see Abstract).

One of ordinary skill in the art would not have thought to have modified Imanishi in view of Oishi because there is no motivation for this modification.

The Office Action asserts that the motivation for modifying Imanishi is “to provide a means of making the magnesium hydroxide required by the process of Imanishi but not disclosed.”

This so-called motivation has no evidentiary basis. The mere fact that references can be combined or modified is not *prima facie* obviousness. Although a prior art reference can be modified to run the way an apparatus is claimed, there must be a suggestion or motivation in the reference to do so. There must be some objective reason to combine the teachings of the references, beyond a statement that the modifications would have been well within the ordinary skill of the art. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Without some objective reason to modify the process of Imanishi, the rejection fails to meet a case of *prima facie* obviousness. Imanishi is not concerned with obtaining a hexagonal crystal form. There is no reason why one would have used the method for making this crystal form in the resin composition of Imanishi.

In view of the foregoing, each of independent claims 1, 11-14, 21, 23-24, 27 and 32.

Moreover, claim 11 is patentable also due to the recitation of presence of the silica particles *during the reaction* of the magnesium salt and metal hydroxide. This aspect of the claimed invention is not taught or suggested by the combination cited references.

The remaining rejections are directed to the dependent claims. These claims are patentable for at least the same reasons as the independent claims, by virtue of their dependency therefrom.

**Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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